

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-9 were pending.

New Claims 10-17 have been added and are considered patentably distinguishable over the prior art cited. Claim 10 recites (quoted here for convenience):

An energy absorbing safety barrier system comprising:
a plurality of plates affixed to a retaining wall in an overlapping manner to inhibit shearing of said system and dispersal of sheared objects;
a plurality of fins depending from said plurality of plates, said plurality of fins deformable for dissipating energy generated by impact of a vehicle thereon;
and
each one of said fins having a free side and an affixed side, wherein a weld traversing the lengths of said affixed side affixes said fin to said plate.

The prior art cited fails to disclose or claim every element of Claim 10, including a plurality of plates affixed to a retaining wall in an overlapping manner, a plurality of fins depending from the plates, and a weld that traverses the length of one side of the fin, the weld affixing the fin to the plate. As such, Claim 10 is patentably distinguishable over the prior art, and Claims 11-17 are considered patentably distinguishable due to their respective dependence from Claim 10.

In undertaking to determine whether one reference anticipates the claim(s) of an application

under 35 U.S.C. § 102(a), § 102(b) or § 102(e), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Kiedaisch et al. ('010) fails to disclose or claim every element of Claims 1, 2, 5 and 6-9 as required, therefore, Claims 1, 2, and 5-9 are patentably distinguishable over Kiedaisch et al. ('010).

Claim 1 recites (quoted here for convenience):

An energy absorbing safety barrier system comprising:
a plurality of plates affixed to a retaining wall in an overlapping manner to inhibit shearing of said system and dispersal of sheared objects;
a plurality of fins depending from said plurality of plates, said plurality of fins deformable for dissipating energy generated by impact of a vehicle thereon.

The safety barrier system of Claim 1 has a plurality of plates affixed to a retaining wall in an *overlapping manner to inhibit shearing* of the system and *dispersal* of sheared object. In contrast, Kiedaisch et al. ('010) discloses an anchor system (62) affixed to a support structure (14), but the anchor system (62) is not affixed in an overlapping manner, demonstrated by the linear distance separating each respective anchor system (62), seen in FIGS. 2, 3 and 7, respectively. Furthermore, the examiner has recited that Kiedaisch et al. ('010) discloses "[a] plurality of individual support structures (14) which are affixed by fasteners (64) to the barrier wall in an overlapping manner." (Detailed Action, 07/22/2004, pg. 2, item 1, lines 10-11). In Kiedaisch et al. ('010), reference numeral (14) is labeled as a "support structure" that is "mounted or embedded in place along a side of road 12." (Column 3, Lines 35-36). The support structure (14) of Kiedaisch et al. ('010) is a retaining wall (see FIGS. 1, 2 and 5, respectively)

and not a plurality of plates *affixed to a retaining wall*. Therefore, Kiedaisch et al. ('010) fails to disclose a plurality of plates affixed to a retaining wall in an overlapping manner, and therefore fails to disclose every element of Claim 1 as required. Thus, Claim 1 is patentably distinguishable over Kiedaisch et al. ('010). Claims 2-9, as dependent from an allowable Claim 1, are also patentably distinguishable over the prior art cited.

Likewise, as to Claim 1, Kiedaisch et al. ('010) fails to disclose a system having fins depending from plates, and that the fins depending from the plates are deformable. Therefore, Kiedaisch et al. ('010) fails to disclose every element of Claim 1 as required. Thus, Claim 1 is patentably distinguishable over Kiedaisch et al. ('010). Claims 2-9, as dependent from an allowable Claim 1, are also patentably distinguishable over the prior art cited.

The key (64) of Kiedaisch et al. ('010) is cited as disclosing the "fasteners" of the present invention recited in Claim 2. However, the key (64) is described as a "T-shaped protuberance at least partially embedded in the concrete forming support structure 14, key 64 may alternatively be integrally formed as part of a single unitary body with support structure 14." (Column 6, Lines 45-49). The fasteners of the present invention secure the plates to the retaining wall, but are not embedded or formed as part of the construction of the retaining wall. Furthermore, the key 64 corresponds to a key way slot 66 to "releasably secure fender element 16 to support structure 14" (Column 6, Lines 25-26). The fasteners of the present invention have no such cooperation or relationship to the fins, since the fasteners are used to affix the plates to the retaining wall only. Therefore, Kiedaisch et al. ('010) fails to disclose the fasteners used for affixing plates to a retaining wall of Claim 2, and therefore fails to disclose every element of

Claim 2 as required. Thus, Claim 2 is patentably distinguishable over Kiedaisch et al. ('010).

Kiedaisch et al. ('010) fails to disclose that each fin is welded to a plate. The examiner stated:

".... Kiedaisch et al. clearly discloses alternative embodiments, wherein a separate barrier wall supports the support structures (14) via fasteners (64), which are integral with the barrier wall." (Detailed Action, 07/22/2004, pg. 2, item 1, line 21 and pg. 3, item 1 cont'd, lines 1-2). To reiterate, support structure (14) is a retaining wall. It is unclear why a separate barrier wall would be included in the system to support the retaining wall, and that the barrier wall would be coupled to the retaining wall by fasteners. Also, to reiterate, the key (64) is not equivalent to the fasteners of the present invention for the reasons stated in the preceding paragraph, herein incorporated by reference as if fully rewritten.

Therefore, Kiedaisch et al. ('010) fails to disclose the welds used for affixing each fin to a plate of Claim 5, and therefore fails to disclose every element of Claim 5 as required. Thus, Claim 5 is patentably distinguishable over Kiedaisch et al. ('010).

Therefore, in view of the aforementioned differences between Claims 1, 2 and 5-9 of the present invention and Kiedaisch et al. ('010), Claims 1, 2 and 5-9 are patentably distinguishable over Kiedaisch et al. ('010).

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

The combination of Kiedaisch et al. ('010) and Bastis et al. are cited as disclosing, teaching, suggesting or claiming every element of Claim 3. To reiterate, support structure (14) is a retaining wall and is not a plate as recited in the present invention. Furthermore, Bastis et al. discloses a lap joint for a highway guard rail, with adjacent "guard rail panels 12 *joined together* to form a continuous longitudinal rail system 10 supported by posts 11." (Emphasis Added). (Column 1, Lines 42-44). The present invention recites a margin that is vertically disposed and offset from the plane of the plate so as to overlap the planar margin of an adjacent plate. The offset and planar margins are NOT joined together. And, the margins are not supported by posts, as the device in Bastis et al. is supported. As such, the combination of Kiedaisch et al. ('010) and Bastis et al. fails to disclose, teach, suggestion or claim every element of Claim 3, as required, therefore Claim 3 is patentably distinguishable over Kiedaisch et al. ('010) and Bastis et al.

Claim 4 is dependent from an allowable Claim 1, and is therefore considered allowable over Kiedaisch et al. ('010) and Kiedaisch et al. ('140).

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make

the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a safety barrier system having a plurality of plates affixed to a retaining wall, wherein the plates have a plurality of fins depending therefrom for absorbing and dissipating energy delivered by the impact of an automobile. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design,

other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,


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